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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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K&L Gates LLP				
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EXAMINER				
DANNEMAN, PAUL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,782

Applicant(s)

ITABASHI, TATSUO

Examiner

PAUL DANNEMAN

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 February 2009 has been entered.

Response to Amendment

2. Independent Claims 1, 2, 7 and 8 have been amended.
3. Claims 1-25, 27 and 28 are pending and have been examined in this application.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 2, 7 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 21-25** are rejected under 35 U.S.C. 101 because the preamble recites a apparatus per se which may be equated to that of interconnected devices which is defined by its physical structural elements and corresponding functionality. No physical structural elements are recited; the claims are directed to non statutory subject matter. The body of the claims comprises software modules, which are virtual modules not physical structures.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 21-25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent Claim 21 is directed to an "information-processing apparatus for managing electronic values..." It is unclear what or which information-processing apparatus Applicant is referring to rendering the claim unclear and indefinite. For purposes of this examination, the Examiner is interpreting these claims as referring to the Applicant's value apparatus.

9. **Claim elements 9-11** are a "***means plus function***" limitation that invokes 35 U.S.C. 112, sixth paragraph. However the written description fails to disclose the corresponding structure, material, or act for the claimed function. The claim elements disclose the following functions "receiving a payment", "issuing a right", "authenticating said value apparatus", and "authenticating said payment notification", however the written description fails to sufficiently disclose the structure for performing the functions as recited in these claims. See MPEP §§ 6.08.01(o) and 2181 and 37 CFR 1.75(d). Proper correction is required.

10. **Claim elements 15-17** are a "***means plus function***" limitation that invokes 35 U.S.C. 112, sixth paragraph. However the written description fails to disclose the corresponding structure, material, or act for the claimed function. The claim elements disclose the following functions "requesting a value", "acquiring a utilization right", "providing a utilization right", "authenticating said value apparatus" and "authenticating said user", however the written description fails to sufficiently disclose the structure for performing the functions as recited in these claims. See MPEP §§ 6.08.01(o) and 2181 and 37 CFR 1.75(d). Proper correction is required.

11. **Claim element 21** is a "***means plus function***" limitation that invokes 35 U.S.C. 112, sixth paragraph. However the written description fails to disclose the corresponding structure, material, or act

for the claimed function. The claim elements disclose the following functions "making an electronic-value payment", "transmitting a payment notification", and "managing said electronic values", however the written description fails to sufficiently disclose the structure for performing the functions as recited in these claims. See MPEP §§ 6.08.01(o) and 2181 and 37 CFR 1.75(d). Proper correction is required.

Claim Rejections - 35 USC § 103

12. **Claims 1-25 and 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama et al., US 2004/0103063 A1, henceforth known as Takayama.

Claims 1-2, 4, 7-9, 13-15, 19-20 and 27-28:

With regard to the system limitations comprised of:

- A terminal operated by a user for requesting a resource through a second main apparatus that is provided by the first main apparatus;
- Acquiring a right to utilize the resource;
- A first main apparatus for providing a resource comprised of a payment-notification receiver for receiving from the value apparatus notification that an electronic-value for utilizing a resource has been paid by the second main apparatus;
- The first main apparatus allowing the terminal to utilize the resource provided by the first main apparatus when said terminal shows a right to utilize the resource;
- A second main apparatus for requesting an electronic-value payment from a value apparatus to a first main apparatus when a terminal requests a resource;
- Acquiring a resource utilization right issued by the first main apparatus in accordance with an electronic-value payment;

- A value apparatus comprised of a means for making an electronic-value payment to the first main apparatus in accordance with a request received from the second main apparatus; and
- A payment-notification sender for transmitting a payment notification to first main apparatus of an electronic-value payment.

Takayama in at least Fig.1 and paragraphs [0126 and 0127] discloses an electronic value issuing server 2 (value apparatus), a service server 3 (first main apparatus), a user's portable terminal 5 and a private electronic value bank 7 via a network 1. Takayama in at least Fig.2 and paragraph [0129] further discloses a portable terminal 5 attached with a smart card 5a and able to operate the electronic value cached in the mobile electronic wallet 5b (second main apparatus) and the electronic value controlled in the electronic wallet 7a of the bank 7.

Takayama in at least Fig.5 discloses the second main apparatus making an electronic value issue request to a value apparatus 2 for a service/resource provided by (Fig.1) a first main apparatus 3. Also disclosed is a first main apparatus receiving a payment-notification from a value apparatus 2 for use of a resource paid for by the second main apparatus.

Takayama in at least Fig.1 further discloses the portable terminal receiving a service/resource utilization right issued by the first main apparatus service server 3 to a user terminal which has requested a resource.

Takayama in at least Fig.2 and paragraph [0210] discloses that the electronic value purchase request may include a certificate of a third party which shows that the price has been paid.

Claims 3, 11 and 16-17:

With regards to the limitation of an information-processing apparatus of Claim 2:

- *A means for authenticating a user in conjunction with a second main apparatus based on personal information stored in the second main apparatus.*

Takayama in at least paragraph [0127] the use of personal authentication information (e.g. PIN – Personal Identity Number) for authenticating a user.

Claim 5:

With regard to the limitation of an information-processing apparatus of Claim 2:

- ***Wherein resource-request signal sender (terminal) and the utilization-right acquisition means (first main apparatus) exchange data with the second main apparatus by encrypting data.***

Takayama in at least paragraph [0282] discloses that the exchange of data between all parties is data encrypted.

Claims 6, 12, 18 and 25:

With regard to the limitation of an information-processing apparatus of Claim 2:

- ***Wherein the resource/service is an apparatus, information, or a license issued for information.***

Takayama in at least paragraph [0252] discloses that the service may be a music download service, a bill payment service and in paragraph [0251] obtaining money transfer information.

Claim 21:

With regard to the limitations of the information-processing apparatus for managing electronic values:

- ***Electronic-value payments means for making an electronic-value payment to the first main apparatus for providing a resource requested by a user made by a second main apparatus for storing personal information of the user;***
- ***Payment-notification sender for transmitting payment notification to first main apparatus that an electronic-value payment was made to the first main apparatus from the second main apparatus; and***

Takayama in at least Fig.5 discloses the second main apparatus making an electronic value issue request to a value apparatus 2 for a service/resource provided by (Fig.1) a first main apparatus 3.

Also disclosed is a first main apparatus receiving a payment-notification from a value apparatus 2 for use of a resource paid for by the second main apparatus.

- ***An electronic-value managing means for managing an account by using an apparatus ID included in a certificate or by using an ID associated with the apparatus ID.***

Takayama in at least paragraphs [0127, 0128 and 0134] discloses the use of a PIN for authenticating a user and the use of a digital certificate and a private key when using the electronic credit card or debit card for a purchase. Takayama in at least paragraphs [0151 and 0158] further discloses the use of a session number when conducting a financial transaction.

Claim 22:

With regard to the limitation for the information-processing apparatus for managing electronic values of claim 21:

- ***Including an authentication means for authenticating said information-processing apparatus itself in conjunction with the first and second main apparatus as a valid apparatus for managing electronic values.***

Takayama in at least paragraph [0037] discloses that the private electronic value bank system of the present invention is also characterized in that the portable terminal transmits an electronic value issue request message including issue instruction information and purchase instruction information, which has been encrypted. Takayama does not specifically disclose an authentication means for the value apparatus per se, however in at least paragraph [0038] Takayama discloses that security in issuing the electronic value via the network and its settlement can be improved. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Takayama with additional security and authentication features to validate the various apparatus with the motivation of increasing security of the related transactions.

Claim 23:

With regard to the limitation for the information-processing apparatus of claim 21:

- *Including a storage means for storing electronic value of said first and second main apparatus, wherein said electronic-value payment means makes an electronic-value payment from the second main apparatus to the first main apparatus by renewing electronic value stored in said storage means.*

Takayama does not specifically disclose that the value apparatus (value issuing server) stores the electronic value per se. However Takayama in at least Fig.3, Fig.5 and paragraphs [0160-0173] discloses that the value apparatus (value issuing server 2) generates the electronic value and transmits it to the electronic wallet. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify the value apparatus with a storage means for the storage of the electronic value with the motivation of securely storing the electronic values which the value apparatus transmits to the electronic wallet.

Claim 24:

With regard to the limitation for the information-processing apparatus of claim 21:

- *Electronic-value payment means is capable of making an electronic-value payment from second main apparatus to first main apparatus by acquiring an electronic value from second main apparatus and transferring said electronic value to first main apparatus.*

Takayama in at least Fig.1, Fig.2 and paragraphs [0135-145] discloses that the value apparatus (value issuing server 2) generates the electronic value between the second main apparatus (portable terminal with electronic wallet) to the first main apparatus (server 3/4).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

3 April 2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627